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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,337	09/10/2003	Willard C. Wacha	19080.04	1868

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HESLIN ROTHENBERG FARLEY & MESITI PC  
5 COLUMBIA CIRCLE  
ALBANY, NY 12203

EXAMINER
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ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,337	<b>Applicant(s)</b> WACHA, WILLARD C.	
	<b>Examiner</b> Darren W. Ark	<b>Art Unit</b> 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 16-35 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 16-25 and 27-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/25/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claim 26 (drawn to non-elected embodiment of Fig. 4) is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/29/2004.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 4/25/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, a copy of reference AA has not been included along with the IDS filed 4/25/2005.

### ***Response to Amendment***

3. Claims 2-15 were canceled by the amendment filed 8/16/2004 and therefore the present status of claims 12 and 13 are canceled.

***Drawings***

4. The drawings (Fig. 3) were received on 4/25/2005. These drawings are approved by the Examiner.
5. The drawings are objected to because there appears to be a third aperture at the very end of the neck portion or rearward end of the body that is not labeled (which may be important in claiming the location at which the hook is attached; if a reference number is added then the specification should also be amended to discuss this overlooked feature). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 16, 17, 29-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 1, the specification do not disclose the hook in Fig. 6 (the elected Species) as being attached between the first and second apertures, instead the hook is attached rearward of the first (40) and second (60) aperture.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 16, 17, 29-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the phrase "a hook attached...between the first aperture and the second aperture..." renders the claim vague and indefinite since in Fig. 6 the hook is attached behind both the first and second apertures (40, 60).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 16, 32-33, 35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ehlers 4,893,431.

Ehlers discloses a tear-drop shaped lip (14) with a first portion (18) having a first aperture (22, 24) and a second portion (16, 46) and having a second aperture (through which 58 extends); a punched out strap (rib 26, 30 OR 30 has two ends which are attached via the connection at 28, 32; strap not particularly claimed since "integral" is defined as "1. Essential for completeness. 2. Having everything required: ENTIRE"); a fish hook (40, 42) with a shank (52, 54) extending from the second portion of the lip (46) adjacent the second aperture (at 58), the hook being secured to the lip by molded material (12 made of plastic) encasing the shank and second portion of the lip (see Fig. 2); a pair of bait holders extending laterally from the molded material (barbs on hooks 40, 42 OR 44 OR sides of 12; the bait holders are not particularly claimed).

12. Claims 18-25, 27-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marshall 5,077,931.

Marshall discloses a body (11 in Figs. 7, 8) with a lip portion (portion of 11 at and forward of 40 extending to 12) with a rounded outer edge (at 12) tapering into a substantially flat, narrow elongated neck portion (portion rearward of 40; transition

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between the lip and neck not particularly claimed) with parallel opposed sides (flat sides are parallel); a first aperture (at 18); means for receiving a line (22) comprising a punched out strap (22 along with forward edge of 20 defines a narrow area that is a strap) protruding from the lip (the narrow area protrudes from the front of the lip); a second aperture (24 or 22); and means for promoting sinking when exposed to a flow of water comprised of a raised lip (concave shape of 12 defines outer edge which is raised higher relative to the rest of the surface; also weight of 40) and positioning of the lip portion such that it is non-planar with the neck portion (see Fig. 7); a plurality of spurs (50).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers 4,893,431.

Ehlers discloses the lip made of metal but not of non-toxic metal or plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of non-toxic metal or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because a

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non-toxic metal would lessen pollution and because plastic can be molded in many different shapes, sizes, and configurations. *In re Leshin*, 125 USPQ 416.

15. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Perry 2,538,703.

Alternatively, Marshall does not disclose a punched out strap. Perry discloses a punched out strap (rib 26). It would have been obvious to a person of ordinary skill in the art to modify the means for receiving a line of Marshall such that it is in the form of a punched out strap in view of Perry in order to provide a means for receiving the line which extends outwardly from the surface of the lip so it is positioned to facilitate threading the line for engagement therewith.

16. Claims 1, 16, 17, 29-32, 34, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830.

Marshall discloses a lip (11) with front (12) and back portions (portion of 11 rearward of 40), a strap (defined between 20 & 22), a first aperture (24), a second aperture (at 18), a plurality of spurs (50), and the hook attached between the first and second apertures (24 and at 18 in Figs. 7, 8), but does not disclose the hook attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures. Brott, II discloses a hook (14) attached to the lip (12) by molded material (16 of lead) encasing an end of the hook and a portion of the lip which includes a first (30) and second (50) apertures (see Fig. 7). It would have been obvious to a person of ordinary skill in the art to modify the device of Marshall such that the hook is attached to the lip by molded material encasing an end of the hook and the area



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between the first and second apertures in view of Brott, II in order to provide a means for permanently fixes the lip and hook together rigidly and positionally with respect to each other and also provides additional weight to the lip so as to sink more quickly and to greater depths.

In regard to claim 16, see col. 3, lines 20-31.

In regard to claim 17, Marshall and Brott, II discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because plastic can be molded in many different shapes, sizes, and configurations. *In re Leshin*, 125 USPQ 416.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Peters et al. 3,344,549 or Lievense 2,886,914.

Marshall and Brott, II do not disclose the lip made of plastic. Peters et al. and Lievense disclose the lip (25 or 1) made out of plastic (transparent or translucent plastic). It would have been obvious to a person of ordinary skill in the art to make the lip of Marshall and Brott, II such that it is made out of transparent or translucent plastic in view of Peters et al. or Lievense in order to provide a lip which is difficult to be seen by the fish.

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18. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Wicht 5,588,247.

Marshall and Brott, II do not disclose the molded material being one of a non-toxic metal or a polymer. Wicht discloses the body (10), body extension (11), and cap (24) being formed from a non-toxic metal (lead-free brass) because of environmental concerns. It would have been obvious to a person of ordinary skill in the art to make the molded material of Marshall and Brott, II out of a non-toxic metal in view of Wicht in order to provide a sinker material which provides the necessary mass yet will not pollute the environment if lost.

19. Claims 18-25, 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Edwards 1,997,900 or Finucan 2,218,259.

Alternatively, Marshall does not disclose the body with a substantially flat, broad lip portion. Edwards and Finucan disclose body with flat, broad lip portions (3 or 32, 33) and means for promoting sinking comprising a raised edge on the broad lip portion (8 or 30, 31). It would have been obvious to a person of ordinary skill in the art to modify the body of Marshall such that it has a flat broad lip portion and a raised edge on the lip portion in view of Edwards and Finucan in order to provide a lip configuration that can provide the desired hydrodynamic profile to thereby produce the desired erratic motion in the water.

***Response to Arguments***

20. Applicant's arguments filed 4/25/2005 have been fully considered but they are not persuasive.

In regard to applicant's argument that "...reach 46 of Ehlers does not comprise the lip 14 of Ehlers but is distinct from the lip 14...the hook 50 is not attached 'between the first aperture and the second aperture'...", the Examiner contends that at col. 3, lines 37-39 recites that "Lip 14 has...reach 46..." and that the most forward extending portion of loop (56) is positioned between the first and second apertures so that the hook is indeed attached along the bottom of the lip at an area between the apertures, therefore the limitations are met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA